

REMARKS

I. Introduction

This application is a continuation of U.S. Patent Application. No. 09/887,897 filed June 22, 2001. An Office Action dated July 16, 2003 was previously issued in connection with the parent application. Claims 1-12 were pending in the parent application. In the July 16, 2003 Office Action, claims 1, 2, 4-9 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious from Young et al. U.S. Patent No. 5,479,268 ("Young") in view of Gough et al. U.S. Patent No. 5,638,501 ("Gough"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Gough and further in view of Hamilton et al. U.S. Patent No. 5,579,055 ("Hamilton"). Claims 1-12 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-11 were rejected under the doctrine of obviousness-type double patenting as being unpatentable over various claims of Marshall et al. U.S. Patent No. 6,020,929. Claims 3 and 11 were indicated to be allowable over the references of record.

II. The § 103 Rejections

Claims 1, 2, 4-9 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Gough. Claim 10 was rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Gough and further in view of Hamilton. These rejections are respectfully traversed.*

* In the Office Action, the Examiner alleges that somewhere in the references of record there is an "explicit teaching" of applicants' claimed invention. Office Action, page 4, lines 6 and 7. However, this is plainly not the case. Applicants'

Applicants' claims 1, 2, 4-10 and 12 are directed to superimposing an interactive program guide with a perceived partial transparency over a television program. As set forth in § 4 of the Office Action, the Examiner relies on two portions of Young to make § 103 rejections of applicants' claims: (1) FIG. 9 of Young, which shows the display of an opaque, partial-screen program guide overlay on top of a television program; and (2) the following portion of Young at column 14, lines 31-33:

The user interface presents
supplemental schedule information in
overlays that obscure a minimal amount
of useful other information.

(emphasis added). This portion of Young will be referred to hereinafter as the "column 14 citation."

In particular, the Examiner contends that Young's column 14 citation would have motivated one of ordinary skill in the art to modify Young's FIG. 9 based on Gough in such a way as to meet the requirements of applicants' claims. The linchpin of the Examiner's argument is that Young's FIG. 9 is "an example" of what is being discussed in Young's column 14 citation:

Young . . . specifically addresses the
issue of overlaying schedule
information in a manner which obscures
a minimum amount of other useful

claims have been rejected as being obvious under § 103, not as being anticipated under § 102. Furthermore, applicants submit that there is no "explicit teaching" of applicants' claimed invention in any of the references of record. Accordingly, applicants believe that the statements regarding the alleged "explicit teaching" of applicants' claimed invention are in error. If applicants' belief is incorrect, applicants respectfully request clarification from the Examiner in the next Office Action.

information (e.g. col. 14, lines 31-33), and gives an example of overlaying limited schedule information on a video program in such a manner (e.g. FIG. 9).

Office Action, § 4 (emphasis added). Applicants respectfully disagree, and submit that the Examiner has pieced two unrelated portions of Young together without any support in Young for doing so, and as a result, has read into Young a motivation that is simply not there.

Contrary to the Examiner's contention, FIG. 9 is not "an example" of what is being discussed in Young's column 14 citation. Young does not refer to the television program of FIG. 9, or to any other television program for that matter, as "information." Rather, Young maintains the distinction by referring to television programs as "programs" and to information as "information." For example, when Young describes FIG. 9, Young uses the term "information" to describe what is displayed in the program guide overlay. Young, col. 7, line 58 to col. 8, line 8. Young does not refer to the underlying television program of FIG. 9 as "information," and instead uses the term "program" for this purpose.* Id. Young therefore makes plain that the phrase "other useful information" of the column 14 citation is not the television program of FIG. 9.

* Similarly, in reference to its system for keeping track of the programs recorded to a VHS tape, Young uses the term "information" to describe what is recorded to the control track of the VHS tape (e.g., program title, program length, date recorded) and not to describe the program itself. Young, col. 3, lines 14-25; see also Young, col. 9, lines 11-25.

Moreover, nowhere in its description of FIG. 9 does Young disclose a concern for obscuring only "a minimal amount" of the underlying television program. Rather, Young discloses that, as a user changes channels, an opaque "channel grazing" overlay is displayed for the purpose of informing the user about what is being shown on the currently-tuned channel. Young, col. 7, line 58, to col. 8, line 8.* In fact, Young's channel grazing overlay of FIG. 10 appears to unnecessarily obscure part of the underlying television program. That is, the overlay of FIG. 10 includes a region that obscures part of the underlying television program without conveying any additional program schedule information to the user. For the Examiner's convenience, applicants have attached as Appendix A a marked-copy of Young's FIG. 10 showing this region in red.

Finally, the portion of Young that can be fairly read to be "an example" of Young's column 14 citation merely relates to the display of supplemental schedule information on top of other schedule information, and not to the display of schedule information on top of a television program as the Examiner suggests. In particular, Young discloses that supplemental program schedule information (e.g., a program description) for a selected program listing is displayed in an opaque, partial-screen overlay on top of a program listings grid guide in a way that "minimize[s] concealment of the guide." Young, col. 6, lines 25-54 (emphasis added); see also Young FIG. 6. That is, the opaque overlay is displayed on either the top or bottom half of the grid guide, as necessary, to avoid masking the title of

* The channel grazing mode of Young's system is sometimes referred to in the art as a "Flip" mode.

the selected listing. Young refers to this as its "auto-roving" program note overlay, and does not disclose using this feature in connection with an underlying television program.*

In sum, Young's column 14 citation does not relate to displaying a program guide on top of a television program, and therefore, FIG. 9 is not "an example" of this citation. Thus, the Examiner's reliance on the column 14 citation for the alleged motivation to modify Young's FIG. 9 is clearly improper.

Furthermore, applicants respectfully submit that there is no other portion of either Young or Gough that provides motivation to modify Young's system in the manner suggested by the Examiner. As even the Examiner points out, Young already provides a way for the user to view a television program and a program guide at the same time -- i.e., Young overlays an opaque, partial-screen program guide overlay on top of the television program. Young, col. 7, line 58 to col. 8, line 8; see also Young FIGS. 9 and 10. Neither Young nor Gough provides any suggestion or motivation to deviate from this plain teaching.

Notably, the problem that Gough is directed to solving is not a problem in program guide systems. In particular, Gough relates to systems having limited display areas in which a user enters data into a data field using an on-screen keyboard. Gough, col. 6, lines 8-64; see also col. 1, lines 14-22 and col.

* Furthermore, applicants submit that there is also no motivation to use Young's auto-roving overlay in connection with an underlying television program. In particular, there is no suggestion of how or why Young's stated purpose of preventing the masking of a selected program listing would apply to a television program. Moreover, Young does not disclose that any particular region of a television program can be selected.

3 lines 16-22. The lack of display area in these systems leaves Gough no other choice but to display the keyboard on top of the data field. To deal with this problem, Gough displays its keyboard with a translucent effect so that both the keyboard and the data field can be viewed at the same time. See, e.g., Gough, FIGS. 3 and 4.

Program guide systems such as applicants' system, however, are not faced with this problem, because such systems have sufficient display area to allow such a keyboard and data field to be displayed in separate regions of the display. In other words, there would be no need to display the keyboard on top of the data field. To illustrate this point, applicants have attached as Appendix B a screen shot from an interactive television program guide that shows an on-screen keyboard and a data field displayed in separate regions of a display.*

Accordingly, it would have not been obvious to modify Young's system in the manner suggested by the Examiner. Therefore, the § 103 rejections are insufficient as a matter of law. Applicants respectfully request that the § 103 rejections of claims 1, 2, 4-10 and 12 be withdrawn.

III. The § 101 Rejection

Claims 1-12 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Examiner contends that the claims are directed only to instructions stored on a storage media and that such

* This screen shot was obtained from the Microsoft IPG 1.5 tutorial at http://www.microsoft.com/tv/MSTV_IPG_Overview.mspx.

instructions are not statutory subject matter within the context of 35 U.S.C. § 101. Office Action, § 3.

Contrary to the Examiner's contentions, applicants submit that claims 1-12 are directed to statutory subject matter under 35 U.S.C. § 101. In particular, claims 1-12 are directed to "computer readable storage media comprising . . . instructions," and not merely to the instructions themselves as the Examiner suggests. It is well-settled that "a claimed computer-readable medium encoded with a computer program is a computer element . . . and is thus statutory." MPEP § 2106.01 I.

Accordingly, applicants respectfully request that the § 101 rejection of claims 1-12 be withdrawn.

IV. The Double Patenting Rejection

Claims 1-11 were rejected under the doctrine of obviousness-type double patenting as being unpatentable over various claims of Marshall et al. U.S. Patent No. 6,020,929 ("Marshall '929 Patent"). Claims 1-11 had been previously been rejected under the doctrine of obviousness-type double patenting as being unpatentable over various claims of Marshall et al. U.S. Patents No. 6,305,016 and No. 5,828,420 ("Marshall '016 and '420 Patents") in Office Actions dated April 2, 2003 and December 21, 2001, respectively, issued in connection with the parent application.

Applicants have submitted herewith a terminal disclaimer under 37 C.F.R. §1.321 (b, c) disclaiming the portion of the term of any patent to be issued on the present application beyond the expiration of the Marshall '929 Patent. For completeness, applicants have also submitted herewith

terminal disclaimers under 37 C.F.R. §1.321 (b, c) disclaiming the portion of the term of any patent to be issued on the present application beyond the expiration of the Marshall '016 and '420 Patents.

Accordingly, applicants respectfully request that the double-patenting rejection of claims 1-11 be withdrawn.

V. Allowed Claims 3 and 11

Applicants wish to thank the Examiner for noting the allowability of claims 3 and 11 over the references of record. Applicants' have not rewritten claim 3 in independent form to recite all the limitations of base claim 1 and intervening claim 2 because, as set forth above, applicants' submit that the base claim and the intervening claim are also allowable over the references of record. However, applicants expressly reserve the right to rewrite claim 3 in independent form should base claim 1 ultimately not be allowed.

VI. Contingent Request for Telephonic Interview

If for any reason the Examiner is unable to allow claims 1-12 based on this Reply, applicants respectfully request a telephonic interview with the Examiner before the issuance of a subsequent Office Action.

VII. Conclusion

Applicants respectfully submit that the foregoing demonstrates that this application is in condition for allowance. Accordingly, prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,



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APPENDIX A
MARKED-UP COPY OF YOUNG FIG. 10

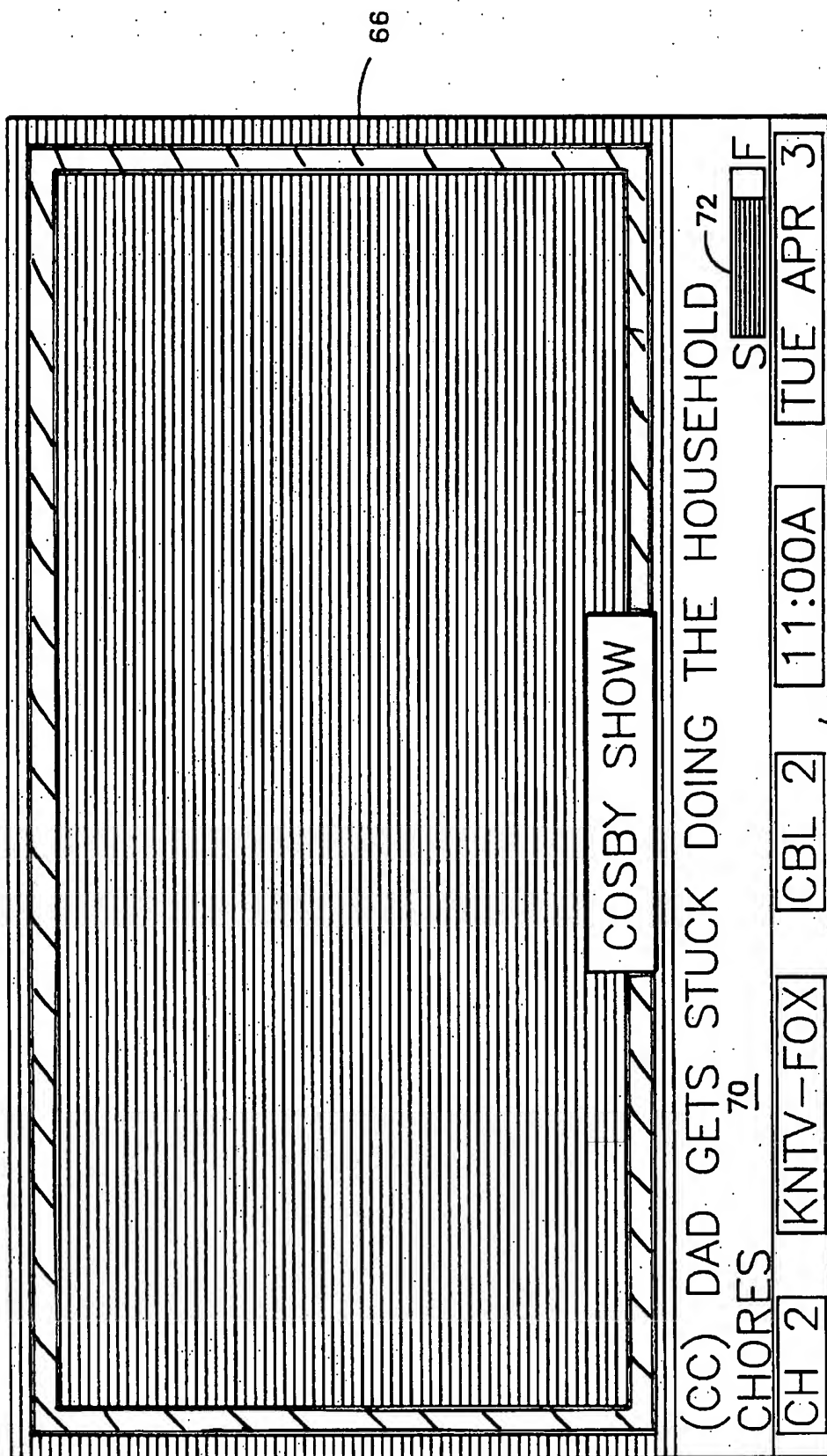


FIG. -10

APPENDIX B
ILLUSTRATIVE PROGRAM GUIDE SCREEN SHOT

APPENDIX C
TERMINAL DISCLAIMERS
RE: MARSHALL '929, '016, and '420 PATENTS